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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :James Austin KENDRICK

Office of Patent Legal Administration

Appl. No. :10/023,677

Senior Legal Advisor: Karin Ferriter

Filed :February 14, 2002

For :CONTINUOUS SLURRY POLYMERIZATION VOLATILE REMOVAL

**REQUEST FOR RE-SEALING OF ENVELOPE CONTAINING IDS
PROPRIETARY MATERIAL, OR ALTERNATIVELY, PETITION TO THE
COMMISSIONER UNDER 37 C.F.R. 1.59(b), TO EXPUNGE INFORMATION
SUBMITTED UNDER MPEP 724.02**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

RECEIVED

MAY 12 2003

Sir:

OFFICE OF PETITIONS

This is a Request for Re-sealing of Envelope Containing IDS Proprietary Material, or alternatively, a Petition to the Commissioner under 37 C.F.R. 1.59(b), to Expunge Information Submitted under MPEP 724.02.

BACKGROUND

An Information Disclosure Statement (IDS) was filed in the above-identified application on September 19, 2002. The IDS included a Declaration by Scott T. Roger (ROGER). The ROGER Declaration contained proprietary material. Accordingly, it was Applicant's intention to submit the ROGER Declaration in a sealed envelope in compliance

with MPEP 724.02. Hence, the ROGER Declaration was intended to be placed in a sealed envelope, the exterior of which was to be labeled so as to make clear that the envelope contained proprietary material and was therefore to remain sealed except for the Examiner's use. The ROGER Declaration was listed on form PTO-1449 as follows: "Declaration of Scott T. Roger As Part Of Supplemental Information Disclosure Statement (proprietary material)". Additionally, Applicant intended to include with the IDS submission, a Transmittal letter as suggested in MPEP 724.02 alerting the PTO to the fact that the ROGER Declaration contains proprietary material and is being submitted for consideration under MPEP 724. Since all requirements of MPEP 724.02 were believed to have been met, it was Applicant's expectation that the ROGER Declaration would become available to the public only upon a determination made by the Examiner that the ROGER Declaration was material to the examination of the above-identified application. Absent such determination, the ROGER Declaration was to be retained in the sealed envelope and unavailable for public inspection. Upon allowance of the above-identified application, and prior to issuance as a patent, it was Applicant's intent to file a Petition under 37 C.F.R. 1.59(b) to have the ROGER Declaration expunged from the file.

PROPRIETARY MATERIAL IMPROPERLY RELEASED BY THE PTO

The above-mentioned sealed envelope believed to have been included with the IDS of September 19, 2002 contains proprietary material which has not been made public by

Applicant, but, based on information and belief, was made available by the PTO to an unauthorized member of the public. It is not clear to Petitioner whether the proprietary material was improperly released by the PTO by (1) making the file of the above-identified application available to an unauthorized member of the public, or (2) making the file of a related application which contained the same proprietary material available to an unauthorized member of the public, or (3) providing a copy of the entire content of the above-identified application, including the proprietary material, to an unauthorized member of the public who requested a copy of the application file, or (4) providing a copy of the entire content of a related application which contained the same proprietary material to an unauthorized member of the public who requested a copy of that application file.

Petitioner visited the U.S. Patent and Trademark Office to visually inspect the above-identified application to ascertain the possible cause for the unauthorized release of the proprietary material. Inspection of the file of the above-identified application revealed that the ROGER Declaration was placed among other documents listed by Applicant on the form PTO-1449. The envelope in which the ROGER Declaration was believed to have been submitted was not located in the application file. Applicant believes that a PTO official may have inadvertently opened the envelope in which the ROGER Declaration was submitted, and discarded the envelope. However, even though Petitioner cannot show conclusively that the submission of the ROGER Declaration in the above-identified application was in compliance with the suggestions in MPEP 724.02, it is clear from the record that any failure

to comply with the suggestions in MPEP 724.02 was due to inadvertence in following clerical procedures which were properly carried out in other related cases. For example, proper procedures were clearly followed in applications 10/147,219 and 09/080,412. Yet, in spite of having followed proper procedures in at least application 10/147,219, the proprietary material which was filed in a sealed envelope as part of the IDS filed on June 17, 2002, was found in that application file outside the envelope, which envelope had been improperly unsealed. The reasons why Petitioner considers the envelope filed in application 10/147,219 to have been improperly unsealed were explained in a concurrently filed Request in application 10/147,219, which, for reasons of brevity will not be repeated herein. Hence, while Petitioner cannot demonstrate with any degree of certainty that proper clerical procedures were followed at the time of filing the proprietary material in the instant application, even if proper procedures had been followed, the PTO would have still likely removed the safeguards followed by Applicant, just as was done in application 10/147,219, leaving the proprietary material in the instant application file in an unsealed condition.

RELIEF SOUGHT

In order to ensure that the proprietary material remains sealed from unauthorized viewing, Petitioner requests that the Commissioner's designee place the proprietary material submitted as part of the IDS filed on September 19, 2002 in a sealed envelope with appropriate markings to ensure that the material is not released to an unauthorized member of

the public. Additionally, should the above-identified application become allowed subsequent to a determination by the Examiner that the proprietary material is not material to patentability, in accordance with MPEP 724.02, Petitioner requests that this paper be considered a Petition under 37 C.F.R. 1.59(b) to have the proprietary material expunged from the above-identified application and returned to Applicant. Applicant will retain the material expunged and returned to Applicant for the duration of the term of any patent maturing from the above-identified application.

ALTERNATIVE RELIEF SOUGHT

In the event that the Senior Legal Adviser refuses to grant the above-stated Relief, Petitioner requests that this paper be considered as a Petition under 37 C.F.R. 1.59(b) to have the ROGER Declaration expunged from the record and returned to Applicant. Upon such return, Applicant will once again submit the ROGER Declaration in a properly sealed envelope as required by MPEP 724.02.

This petition to expunge, submitted as an alternative relief, is being submitted on behalf of the party in interest who originally submitted the documents under seal as part of the IDS.

In view of the fact that Applicant may suffer further harm from unauthorized release by the PTO of the proprietary material, expedited grant of the Relief sought herein is respectfully requested.

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Please charge any fees necessary for consideration of the papers filed herein and refund excess payments to Deposit Account No. 19-0089.

Should the Relief sought herein not be grantable for any reason, the Senior Legal Adviser is invited to contact Petitioner at the below-listed telephone number in order to address any remaining concerns.

Respectfully submitted,
James Austin KENDRICK

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', written over a horizontal line.

Abraham HersHKovitz
Reg. No. 45,294

May 12, 2003
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